REMARKS

I. Status of the Claims

In the Final Office Action mailed on January 22, 2009, the Examiner rejected claims 1-16 under 35 U.S.C. § 112, second paragraph; rejected claims 1, 32, and 63 under 35 U.S.C. § 102(b) as being anticipated by Hoffman (U.S. Patent No. 5,297,026); rejected claims 2-14, 33-45, and 64-76 under 35 U.S.C. § 103(a) as being unpatentable over Hoffman in view of Oncken (U.S. Patent No. 4,985,833); and rejected claims 15, 16, 46, 47, 77, and 78 under 35 U.S.C. § 103(a) as being unpatentable over Hoffman in view of Oncken and Halbrook (U.S. Patent No. 5,987,436). However, Applicants note that in the Office Action Summary page, the Examiner listed claims 1-16, 32-47, and 63-78 as being pending in the application, with only claims 1-16, 32-47, and 63-76 as being rejected. In responding to the Office Action, Applicants assume that claims 77 and 78 are rejected as well.

By this amendment, Applicants have amended claims 1, 3-6, 8, 10, 12, 15, 16, 32, 35-37, 39, 41, 43, 47, 63, 66-68, 70, 72, 74, 77, and 78, and canceled claims 11, 42, and 73 without prejudice and disclaimer. Claims 17-31, 48-32, and 79-93 were previously canceled. Claims 1-10, 12-16, 32-41, 43-47, 63-72, and 74-78 remain pending and under current examination. In view of the following remarks, Applicants respectfully traverse the rejections contained in the Final Office Action.

II. Rejections under 35 U.S.C. § 112

In the Office Action, the Examiner rejected claims 1-16 under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner alleges that "[i]t is unclear who or what is performing the 'receiving' and the 'determining' steps."

Applicants respectfully traverse the rejection. Applicants disagree with the Examiner's allegation. However, solely as an effort to advance prosecution, Applicants have amended claims 1, 3, and 15 to address the Examiner's concern. Accordingly, Applicants submit that claims 1-16 are clear and definite and the rejection of claims 1-16 under 35 U.S.C. § 112 should be withdrawn.

III. Rejections under 35 U.S.C § 102(b)

Applicants respectfully traverse the rejections of claims 1, 32, and 63 under 35 U.S.C. § 102(b) because Hoffman fails to disclose each and every element of Applicants' claims.

In order to properly establish anticipation under 35 U.S.C. § 102, the Federal Circuit has held that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). *See also* M.P.E.P. § 2131.

Hoffman is directed to a method for "grant[ing] the customer a high rate of interest on funds invested with the firm by the customer, provided the customer makes purchases" at an offering entity that offers goods or services to the customer. (Hoffman, Abstract and 2:32-47.) Hoffman appears to teach that the funds within the customer's deposit account are pooled by the offering entity with other customer accounts and used by the offering entity to make investments. (Id. at 5:3-13.) With regard to re-investing

the pooled funds, Hoffman at most discloses that "[t]he offering entity 32 actually invests these investment funds, for example in high return institutional investments 50, which provide a [higher] return to the offering entity" than the return offered by the offering entity to the individual customers, (Id. at 5:58-61,) or alternatively, the "[i]nvestment funds from customers can be used to finance the offering entity's own customer credit card account, thus earning a return for the offering entity higher than would be available elsewhere," (Id. at 2:57-68.) However, Hoffman does not disclose at least the following elements as required by claim 1:

> determining, by the processor, a first portion of the financial investment fund to invest in a plurality of certificates of deposit issued by the financial institution, wherein the plurality of certificates of deposit mature at a varying maturity dates with a degree of laddering based on anticipated need for liquidity within the aggregated fund, and wherein the financial institution uses the first portion of the financial investment fund to perform a function of the financial institution wherein the function requires the financial institution to provide cash; and
>
> determining, by the processor, based on the amount of the first portion invested in the plurality of certificates of deposit, a second portion of the financial investment fund for investing in a transaction account, wherein the transaction account is used to fund a withdrawal from the financial investment fund by any investor among the plurality of investors.

In the Office Action, the Examiner pointed to col. 3, lines 1-26 and col. 4, lines 54-61 of Hoffman to allege the teaching of the above-cited two elements. (Office Action at p. 3.) This is incorrect, because the cited passages merely disclose steps for setting up and managing a deposit account for a customer. The cited passages and the

remaining portions of Hoffman do not disclose either of the "determining" steps cited above.

First, while Hoffman mentions "a published certificate of deposit (CD) rate" in connection with determining an "attractive investment rate offered to customers/investors," the disclosure of a CD interest rate has nothing to do with investing the pooled funds in a CD. (Hoffman at 3:1-26.) Therefore, Hoffman fails to disclose "determining ... a first portion of the financial investment fund to invest in a plurality of certificates of deposit issued by the financial institution," as recited by claim 1. Furthermore, since Hoffman merely discloses a published rate associated with CD, it also fails to disclose that "the certificates of deposit mature at a varying maturity dates with a degree of laddering based on anticipated need for liquidity within the aggregated fund," as recited by claim 1. Therefore, Hoffman fails to disclose the first "determining" step as cited above.

Second, although Hoffman discloses "a deposit account 18," this account is established by the offering entity for one specific customer/investor identified by the account number. (Hoffman at 4:54-61.) Therefore, the individual "deposit account" of Hoffman has nothing to do with the claimed "transaction account," which "is used to fund a withdrawal from the financial investment fund by any investor among the plurality of investors," as recited by claim 1. Furthermore, since Hoffman fails to disclose "determining ... a first a first portion of the financial investment fund to invest in a plurality of certificates of deposit issued by the financial institution," it also fails to disclose "determining, based on the amount of the first portion invested in the plurality of certificates of deposit, a second portion of the financial investment fund for investing in a

transaction account," as recited in claim 1. For at least these reasons, Hoffman does not disclose the second "determining" step as cited above, among other things.

Since Hoffman fails to disclose each and every element of each of independent claim 1, the rejection of claim 1 under 35 U.S.C. § 102(b) based on Hoffman is improper and must be withdrawn. Independent claims 32 and 63, while of a different scope from claim 1, include elements similar to those recited in claim 1. For reasons similar to those set forth above, the rejection of claims 32 and 63 under 35 U.S.C. § 102(b) based on Hoffman is also improper and must be withdrawn.

IV. Rejections under 35 U.S.C § 103(a)

Applicants respectfully traverse the rejections of claims 2-16, 33-47, and 64-78 under 35 U.S.C. § 103(a) because a *prima facie* case of obviousness has not been established.

The Office Action has not properly resolved the *Graham* factual inquiries, the proper resolution of which is the requirement for establishing a framework for an objective obviousness analysis. *See* M.P.E.P. § 2141(II), citing to *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), as reiterated by the U.S. Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007).

In particular, the Office Action has not properly determined the scope and content of the prior art. Dependent claims 2-16, 33-47, and 64-78 include all the elements recited in respective independent claims 1, 32, and 63. As discussed above, Hoffman fails to teach or suggest all of the claimed elements, including "determining, by the processor, a first portion of the financial investment fund to invest in a plurality of certificates of deposit issued by the financial institution, wherein the plurality of

certificates of deposit mature at a varying maturity dates with a degree of laddering based on anticipated need for liquidity within the aggregated fund," and "determining, by the processor, based on the amount of the first portion invested in the plurality of certificates of deposit, a second portion of the financial investment fund for investing in a transaction account, wherein the transaction account is used to fund a withdrawal from the financial investment fund by any investor among the plurality of investors," among other things. Oncken, directed to an extended federal insurance regulation system, (Oncken at Abstract,) and Halbrook, directed to a loan data processor, (Halbrook at Abstract,) do not cure the above noted deficiencies of Hoffman. Accordingly, dependent claims 2-16, 33-47, and 64-78 are allowable for at least the same reasons set forth above in connection with claims 1, 32, and 63, as well as by reason of reciting additional features not taught nor suggested by the cited references.

Furthermore, the Office Action has not properly ascertained the differences between the prior art and claims 2-16, 33-47, and 64-78. For example, with respect to claims 2, 33, and 64, the Examiner alleged that Oncken discloses the additional limitations of these claims at col. 2, lines 10-46. This is incorrect. (Office Action at p. 5.) Although Oncken discloses "early withdrawal" from a certificate of deposit and associated penalties (Oncken at 2:44-46), Oncken does not teach or suggest that "the second portion is used when an investor requests" such an early withdrawal, as recited by claims 2, 33, and 64. Therefore, contrary to the Examiner's allegation, Hoffman and Oncken, taken alone or in combination, fail to teach or suggest each and every element of claims 2, 33, and 64.

As another example, with respect to claims 11, 42, and 73, the Examiner further alleged that Oncken discloses the additional limitations of these claims at col. 6, lines 18-35. (Office Action at p. 7.) Although Oncken discloses that "managing financial institute 20 provide depositors 12 with withdrawals 32 as needed," (Oncken at 6:18-20,) such a disclosure has nothing to do with the claimed "transaction account." Therefore, contrary to the Examiner's allegation, Oncken does not teach or suggest that "the transaction account is used to pay for withdrawals from the financial investment fund," as recited by claims 11, 42, and 73. For this additional reason, Hoffman and Oncken, taken alone or in combination, fail to teach or suggest each and every element of claims 11, 42, and 73.

In view of the above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and claims 2-16, 33-47, and 64-78. Consequently, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in view of the prior art. Accordingly, the Examiner has not met the burden of establishing a *prima facie* case of obviousness of claims 2-16, 33-47, and 64-78, and thus, the rejections of these claims under 35 U.S.C. § 103(a) must be withdrawn.

V. CONCLUSION

The preceding remarks are based on the arguments presented in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The pending claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding remarks in favor of patentability are advanced without prejudice to other

bases of patentability. Furthermore, the Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: May 22, 2009

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202-408-4464